

REMARKS:

Claims 10, 12 and 15-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Gemma, Jr. (U.S. 6,663,456).

Claims 13 and 14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Gemma, Jr. in view of Cutler et al. (U.S. 5,122,062).

The previous claims 10 and 12-16 were rejected under 35 U.S.C. §103, which provides in pertinent part:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

The invention to which the statute refers is defined by the claim language of the application when the claims of an application, rather than a patent, are under consideration. Thus, unless the subject matter, as a whole, defined by the claim's language, would have been "obvious", the claim is patentable.

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) set forth what has become known as "the Graham factors" for determining whether claimed subject matter passes muster

under section 103, requiring that "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the art to be resolved." *Id.* at 17. The Court also expected that other factors, or "secondary considerations," could very well be relevant to the obviousness inquiry, and should thus also be accorded consideration when present. *Id.* at 18. Obviousness analysis begins with these factual findings. *Id.*

More recently, in deciding *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ____ (2007) the Court rejected rigid adherence to the "teaching, suggestion, or motivation" test for obviousness adopted in recent years by the Court of Appeals for the Federal Circuit and reaffirmed the *Graham* factors as consistent with its "expansive and flexible approach." In doing so, the Court expressly rejected the application of "preventative rules that deny factfinders recourse to common sense." *Id.* at _____. The Court however reaffirmed the long-established requirement that factual inquiries must reveal that there would have been a reason to combine old elements before a legal case of obviousness is established under section 103 and the reason should be articulated in the record. *Id.* at _____. The Guidelines under *KSR* (Docket No. PTO-P-2007-0031) reiterate these requirements.

In this application, claim 10 was rejected over U.S. Patent No. 6,663,456 to Gemma, Jr., ("Gemma") which discloses a toy including box 1 comprising front wall 3 and puppet manipulator 8, puppet attachment portion 9 of which is visible through a stage opening 13 in an upper portion 20 of wall 3. Puppet

manipulator 8 has a glove-like shape including four fingers comprising puppet attachment portion 9 of manipulator 8 to which puppet figures 10 can be removably attached (Col. 2, lines 48-67 with reference to Fig. 1). An opening 16 in the bottom 7 of box 1 adapted to receive a child's hand permits access to attachment portion 9 for manipulating puppets thereto attached (Col. 2, line 48-Col. 3, line 10 with reference to Figs. 1 and 5). Gemma also discloses, in discussing prior art: a puppet in the likeness of a story character (Col. 1, lines 31-38).

Applicants' claim 10 described a method of teaching children about a culture different from their own culture. Gemma does not disclose a method that includes, *inter alia*, 1) providing a doll costumed to represent a child of a culture different from the children's or 2) providing a video story of a period in the life of a child of a different culture. Therefore there should be articulated reasoning in the record that explains why it would be obvious to one of ordinary skill that claim 10, *as a whole* would have been obvious. Characterizing applicants' invention as merely "variation of the specifics [disclosed by Gemma]," that "simply represent obvious and expected design variations," (Office Action mailed 8/20/2007 at page 3), does not show obviousness in accordance with the Supreme Court's rulings in *Graham* and *KSR*. Applicants' claims were merely deemed obvious variations of Gemma without an articulated basis.

Whether or not one of ordinary skill could have made applicants' invention, the obviousness inquiry is supposed to focus on whether, without any knowledge of the claimed invention, one would have done so. The rejection seems to rely

on a subjective qualitative assessment when it dismisses applicants' invention as not representing a "patentably distinguishable improvement over Gemma," and conflates the Supreme Court's direction by asserting that applicants' claim limitations "fall within the scope of Gemma." Id. Why one of ordinary skill would have invented the subject matter of claim 10 as a whole in view of Gemma is not explained.

Nevertheless, claim 10 has been amended to describe a method that includes passing a costumed doll to children for handling and manipulating finger puppets in accordance with the story of a video presentation while the children are handling the costumed doll. These steps are claimed in combination with other steps in claim 10. Neither Gemma nor U.S. Patent No. 5,122,062 to Cutler et al. ("Cutler") discloses the method described by applicants' amended claim 10 "as a whole". Neither reference recognizes or even contemplates the problems associated with teaching children multi-culturalism and certainly, neither reference discloses the particular method of teaching described by applicants' claim language. Therefore, amended claim 10 is now believed to be in condition for allowance over Gemma and Cutler.

Applicants' amended claim 12 depends from claim 10 adding, *inter alia*, the step of providing an activity book containing a plurality of activity sheets, each having thereon a different activity relating to the second culture. The Patent Office rejected previous claim 12 taking OFFICIAL NOTICE that activity sheets are old and well known. Id. Combining the step of providing activity sheets with the disclosure of Gemma was asserted to show no unexpected results but instead to be a

combination of old elements. Id. The claim language describing the activity book as relating to the different culture was considered an obvious design choice. Id. The rejection did not explain why such a combination would have been obvious nor did it cite prior art showing applicants' claimed method steps, so rejection of claim 12 was improper according to Supreme Court's precedents.

Regardless, claim 12 has been amended to describe a step of providing activity sheets each having thereon a different activity relating to the different culture. Neither Cutler nor Gemma discloses such a step, nor is there any reason that one of ordinary skill would have combined old elements to produce that described by amended claim 12, "as a whole". The claim is therefore believed to be in condition for allowance over the prior art of record.

Claims 13 and 14 were rejected over Gemma in view of Cutler, but again the Patent Office did not identify the specific method steps in the prior art and did not explain why applicants' claims, as a whole, would have been obvious to one of ordinary skill in the art. Reconsideration of these claims in view of the standards for obviousness analysis required by the Supreme Court is therefore requested.

New independent claim 17 describes a method of teaching children that includes multiple sensory stimulation as described in detail by the claim language. This method is believed to be novel and non-obvious in view of the prior art, therefore allowance of claim 17 is respectfully requested.

New claim 18 describes the method of teaching of claim 17 and further includes limiting the time of teaching to prevent over taxation of the attention span of the children. Since the prior art does not disclose or suggest this method step in combination with the steps of claim 17, claim 18 appears to be in condition for allowance.

New claim 19 describes the method of teaching of claim 17 and further includes presenting several teaching episodes, which is not disclosed or suggested by the prior art. New claim 20 adds allowing the children to verbally react to the visual sensory input described by claim 17. These new claims, in respective combination with claim 17, describe methods that are neither taught nor suggested by the prior art and are therefore believed to be in condition for allowance as well.

Accordingly, applicant believes with the changes made to the claims that all remaining claims as now presented are in condition for allowance over the prior art patents of Gemma, Jr. and Cutler et al. whether such art is considered severally under §102 or in combination under §103. Claim allowance is therefore earnestly solicited at the Examiner's earliest convenience.

Respectfully submitted,

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I hereby certify that this correspondence is being facsimile transmitted to the Commissioner for Patents, Mail Stop Amendment, Group Art Unit 3714, Attention: Examiner Timothy A. Musselman (13 pages including cover letter) to Fax No. (571)273-8300 on this 30th day of October, 2007.


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